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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,692

02/19/2004

David S. Benco

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02/15/2006

Richard J. Minnich, Esq.
Fay, Sharpe, Fagan, Minnich & McKee, LLP
Seventh Floor
1100 Superior Avenue
Cleveland, OH 44114-2518

EXAMINER

APPIAH, CHARLES NANA

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/782,692	Applicant(s) BENCO ET AL.	
	Examiner Charles N. Appiah	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-8 and 10-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4, 6-8, 10-12 and 14-18 are rejected under 35 U.S.C. 102(e) as being anticipated by **Ala-Luuko (6,920,332)**.

Regarding claims 1 and 14 Ala-Luuko discloses a method and system for filtering an SMS message sent from an originating terminal to a subscriber terminal in a wireless communications network comprising: providing subscriber-provided authorization criteria via the Internet (client directly, i.e., without involving the system

operator, add or eliminate specific A-subscriber telephone numbers from the blocking service, by way of a World Wide Web or browser-based user interface set up for the client to define those A-subscribers from which the B0subscriber does not wish to receive short messages. See col. 7, lines 61-67), determining authorization of the originating terminal for sending the SMS message to the subscriber terminal using the authorization criteria (Gateway GW receiving the short message and checking through a database query in database DB whether the originating subscriber is entitled or permitted to send the short message ,see col. 6, lines 40-63), and filtering the SMS message based on the determining step (transmission is be blocked indication, leads to notification of blocking of the transmission, see col. 6, line 63 to col. 7, line 5).

Regarding claim 2, Ala-Luuko further discloses wherein the determining step comprises determining the originating terminal is not authorized for sending an SMS message to the subscriber terminal (return of indication whether the A-subscriber could be found in a blocking list associated with the B-subscriber in the database, see col. 7, lines 28-37).

Regarding claim 3, Ala-Luuko further discloses wherein the filtering step includes blocking the SMS message thereby preventing delivery of the SMS message to the subscriber terminal (blocking short message and thereby not transmitting to the B-subscriber if the A-subscriber information was found in the B-subscriber blocking list, see col. 7, lines 33-37).

Regarding claim 4, Ala-Luuko further discloses sending a denial message to the originating terminal indicating the SMS message was not delivered to the subscriber

terminal (senders being notified of the fact that the short messages have not been delivered to the intended recipient, see col. 8, lines 2-8, col. 9, lines 1-6).

Regarding claim 6, Ala-Luuko further discloses wherein the determining step comprises determining the originating terminal is authorized for sending an SMS message to the subscriber terminal (indication of A-subscriber not being found in the B-subscriber blocking list, leading to the transmission of the short message to the B-subscriber, see col. 7, lines 38-58).

Regarding claim 7, Ala-Luuko further discloses wherein the filtering step includes delivering the SMS message to the subscriber terminal (MSC transmits the short message to the B-subscriber, see col. 7, lines 54-58).

Regarding claim 8, Ala-Luuko further discloses wherein the subscriber-provisioned authorization criteria includes terminal identifiers (adding or deleting specific A-subscriber telephone numbers from the blocking service, see col. 7, lines 59-64), and the determining step further comprises comparing a terminal identifier identifying the originating terminal with the subscriber-provided authorization criteria (carrying out a search in database DB of stored B-subscriber information and returning to gateway GW a response indicating whether the A-subscriber information could be found in a blocking list associated with the B-subscriber in the database, see col. 7, lines 27-34).

Regarding claim 10, Ala-Luuko further discloses wherein the providing step further comprises: providing the subscriber authorization via a mobile terminal (client directly adding or eliminating specific A-subscriber telephone numbers from the blocking

service by way of browser-based user interface set up for the client, see col. 7, lines 59-67).

Regarding claims 11 and 12, Ala-Luuko further discloses wherein the authorization criteria is a terminal identifier, which is a phone number (addition or elimination of specific A-subscriber telephone numbers from the blocking service, see col. 7, lines 61-64).

Regarding claim 15, Ala-Luuko further discloses wherein the means for determining authorization comprises a Home location Register (see col. 7, lines 38-58).

Regarding claim 16, Ala-Luuko further discloses wherein the filtering means comprises delivering the SMS message to the subscriber terminal when the originating terminal is authorized to send SMS messages to the subscriber terminal (indication of A-subscriber not being found in the B-subscriber blocking list, leading to the transmission of the short message to the B-subscriber, see col. 7, lines 38-58).

Regarding claim 17, Ala-Luuko further discloses wherein the means for filtering comprises: means for blocking delivery of the SMS message when the originating terminal is not authorized to send SMS messages to the subscriber terminal (blocking short message and thereby not transmitting to the B-subscriber if the A-subscriber information was found in the B-subscriber blocking list, see col. 7, lines 33-37).

Regarding claim 18, Ala-Luuko further discloses means for sending a denial message to the originating terminal indicating the SMS message was not delivered to the subscriber terminal when the originating terminal is not authorized to send SMS messages to the subscriber terminal (senders being notified of the fact that the short

messages have not been delivered to the intended recipient, see col. 8, lines 2-8, col. 9, lines 1-6).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ala-Luuko as applied to claim 4 above, and further in view of Well Known Prior Art (Official Notice).

Regarding claim 5, Ala-Luuko teaches the blocking service sending a notification of a blocked short message to the sender or originator of the short message (see col. 8, lines 1-8, col. 9, lines 1-6), reading on a denial message being sent, but fails to explicitly teach that the denial message is an SMS message.

Examiner maintains that the concept of using short message service messages for providing message notification is very well known in the art and as such Official Notice is taken that it would have been obvious to one of ordinary skill in the art to use a SMS message to convey to a short message denial message to a short message sender or originator in order to prevent the sending of unwanted or unsolicited message transmission which would bottle up limited network resources.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ala-Luuko** as applied to claim 11 above, and further in view of **Allison et al. (6,819,932)**.

Regarding claim 13, Ala-Luuko further discloses that the short message blocking service may be implemented with respect to normal subscriber numbers as well as service-access numbers (see col. 8, lines 6-7), but fails to specifically teach that the terminal identifier is an IP address.

In an analogous field of endeavor, Allison discloses a system and method for preventing delivery of unwanted short message service (SMS) messages wherein a short message discrimination module contains data that include a sending party's identifier that is an IP address (see "spam@aol.com", in Table 1, col. 8, line 45 to col. 9, line 44).

It would therefore have been obvious to one of ordinary skill in the art to combine Allison's unwanted message delivery system with Ala-Luuko's system in order to provide the option of including an IP address as one of the identifiers for making message transmission decisions as taught by Allison.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miller et al. (6,421,707) discloses a wireless multi-media messaging system.

Yang (6,519,468) discloses a system for checking and notifying about message status. Salmi (6,947,396) discloses a system for filtering electronic information to be transferred to a terminal.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA


CHARLES APPIAH
PRIMARY EXAMINER